

REMARKS

Entry of the foregoing amendment and reconsideration of this application are requested. Claims 1, 10 and 12 have been amended, claims 19-22 are newly added and claims 1-22 are now pending in the application.

Regarding the rejection of claims 1-12 under 35 USC §112, second paragraph, claim 1 has been amended to replace the term "tab inserter" with "tab applicator" in line 7. The Examiner has objected to "monitoring means" in line 2 of that claim as having insufficient antecedent basis. While it is believed that "monitoring means" is positively recited, claim 10 has been amended to positively recite "a monitoring device". The relationship between the monitoring device or means and the monitoring station is set forth on pages 4 and 5 of the specification. It is believed that all claims are in compliance with 35 USC §112.

Regarding paragraph 6 of the Office Action, the apparatus claims have been amended to change the term "mark signal means" to "a mark signal device", and to change the term "control means" to "a control arrangement". These amendments are believed to overcome the Examiner's objection.

Claims 1, 2, 6-12 and 13-17 have been rejected under 35 USC §103(a) as being unpatentable over Bjork (US Patent No. 6,295,129 or WO/1998/021568) in view of Schenk (US Patent No. 4,746,020). Claims 1, 2, 6-12 and 13-18 have been rejected under 35 USC §103(a) as being unpatentable over Schenk in view of Bjork. It also appears the Examiner has applied Murayama (US Patent No. 4,547,250) in rejection of claims 1, 2, 6-12 and 13-18. Claims 2-5 have been rejected under 35 USC §103(a) as being unpatentable over Bjork and Schenk as applied to claim 1, or alternatively Schenk, Bjork and Murayama as applied to claim 1 in view of Barilovits (US Patent No. 6,412,535). Claims 8, 9, 17 and 18 have been rejected under 35 USC §103(a) as being unpatentable over Bjork and Schenk, as applied to claims 1, 2, 6, 7 and 13 and further in view of Murayama.

It is noted that the Examiner has rejected all of the claims of this application

under 35 USC §103 either on the basis of Bjork in view of Schnek, or on the basis of Schenk in view of Bjork, though in the case of claim 18 further in view of Murayama. The clarity of the argument presented by the Examiner in the Office Action is appreciated.

Despite the above, it cannot be agreed that Bjork in view of Schenk or Schenk in view of Bjork leads to a conclusion of obviousness, at least so far as claim 1 is concerned. This will be discussed in more detail below.

Unfortunately, the disclosure of Bjork is not particularly clear. It does disclose the marking of a web by means of a label and that label is shown in Figure 2, identified by the numeral 62. It is clear that the label is relatively large-sized and does not, in itself, mark the defect. The description of Bjork positively states that the defect is indicated by a marker 200, which appears to be a small black indicator on the label 62. Further, the label includes information as to both the dimension and position of the defect, indicated at 210 and 220 on the label 62, again as shown in Figure 2. Thus, it is not the label by itself that indicates the location of the defect in the web; rather it is the marker 200, printed on a line, that indicates the location of the defect with the line showing the transverse direction of the web. Though this must be the case, the description of Bjork is silent on this.

Further, it appears from Figure 1 of Bjork that the label 62 is applied along the length of the web - that this is so is apparent from the curvature of the label 62 shown in Figure 1. If so, it must be presumed that the label extends for the **full width** of the web 70 and is not just an indicator tab as shown, described and claimed in the present invention.

Considering now the disclosure of Schenk, as the Examiner has pointed out, this does disclose the use of various marking devices. Column 4, line 55 onwards describes the marking device 14 of the drawings as consisting of numerous [individual] markers 14a, 14b, 14c, . . . which lie alongside one another in the transverse direction and which make it possible to apply an optical, electrical or

magnetic marking to the web.

The question which needs to be resolved is whether, considering Bjork in view of Schenk or Bjork in view of Schenk would result in the invention of the present case. Neither of these specifications discusses measuring the speed of advancement of the web and using a speed signal derived from that measurement to provide timing for the application of a tab, as distinct from a label as described in Bjork. The reader of Schenk may consider replacing his marking device 14 by a full width label 62 as described in Bjork, and particularly since the marking device 14 extends for the full width of the web, and it appears the label of Bjork also is intended to extend for that width, the reader might consider either:

- a. replacing the full width optical, electrical or magnetic marking device 14 of Schenk by the full width labeler of Bjork, or
- b. replacing the full width labeler of Bjork by the full width marking device 14 of Schenk, to allow the application of an optical, electrical or magnetic marking at any required position across the width of the web, rather than a label.

The difference discussed above is most significant. The invention of this application is concerned with industrial processing typically of a web of paper supplied in roll form, suitable for use for printing. An alternative application for this invention is in the textile industry where fabrics are manufactured in the form of an elongate web which is spooled before being supplied to a garment manufacturer. Such webs are relatively wide; though a paper web could typically be as small as 100mm wide, much more usually a paper web will be 1000mm or perhaps even 2500mm wide. Textile webs may also fall within this range of widths.

It would be essentially impossible to apply a marker across the full width of a web of the kind with which this invention is concerned. Neither Bjork nor Schenk give any guidance as to how such relatively wide webs intended for industrial processing could be marked, since both of these prior documents are concerned with rather different kinds of webs. Bjork is concerned with "polymeric film or the like"

(see column 2, lines 59 and 60) and though Bjork does not say, it appears that the films are intended for use as magnetic recording tape. Similarly, Schenk is concerned positively with magnetic tapes used for the manufacture of audio or video tapes (see column 1, lines 44 et seq.). There, Schenk does mention a width of perhaps 700mm, and the tape is then split down subsequently during manufacture of the final audio or video recording tape. The reader would appreciate that the application of a label across the full width of a 700mm tape as shown in Schenk would ruin the entire length of tape even if the defect is very small (perhaps with a width of 1mm or 2mm) and located at some point across the width of the tape.

When processing the marked tape of Schenk, the strip of tape containing the optical, electrical or magnetic mark may be discarded whilst the rest of the width of tape may be employed since the remainder of the tape would carry no spoiling mark. If, however, the disclosure of Schenk were combined with that of Bjork to include a labeling technique, **the entire width of tape** would be spoiled by the full width label of Bjork resulting in very large quantities of Bjork when considering how to improve Schenk. Conversely, the skilled reader of Bjork may well device to adopt the teachings of Schenk in order to minimize wastage and in turn this would **teach away from** the invention of the present case.

The amendment to claim 1 proposed above serves to bring out this most important feature of difference between the **full width marking** of both Bjork (with a **full width** adhesive label) and Schenk (with a **full width** device 14) able to apply a mark at a selected location across the width of the tape, as compared to the device of this invention which applies a tab solely to the edge margin.

Of course, the above ignores the timing aspects which the Examiner has focused upon in the Office Action. The way in which the timing is derived in the present invention (using a speed sensor 16, 17, 18 to detect the speed of advancement of the web) is critical to the correct location for the application of the edge marker of this invention. This is neither disclosed nor suggested in any of the prior documents

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cited by the Examiner and now forms the subject matter to added claims 19-22. These claims are clearly distinguished from the disclosures of Schenk, Bjork and also Murayama.

Favorable reconsideration of this application is requested, after the amendments requested above have been incorporated and taking into account the foregoing comments.

It is now believed that all pending claims are patentable over the prior art, and the Examiner is requested to pass the application to issue with claims 1-22 being deemed allowable.

Respectfully submitted,

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